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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,616

03/29/2004

Robert R. Parsons

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GO DADDY GROUP, INC.
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EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

3689

NOTIFICATION DATE

DELIVERY MODE

03/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

inventions@godaddy.com

Office Action Summary	Application No. 10/811,616	Applicant(s) PARSONS, ROBERT R.	
	Examiner CARRIE A. STRODER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>23 January 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 23 January 2009, wherein:

Claims 1-19 are currently amended.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 23 January 2009 was filed after the mailing date of the non-final rejection on 05 September 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Amendment

1. Applicant's amendments filed 23 January 2009 have been fully considered; Examiner withdraws the objections to the specification and claims. Examiner also withdraws the rejection under 35 U.S.C. 101.

Response to Arguments

2. Applicant's arguments regarding the claim rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive.

3. Applicant states that he disagrees that Go Daddy and Chauchard make the claimed invention obvious because Chauchard teaches away from the claimed invention by (1) using a local

Art Unit: 3689

computer (not a web site) and (2) sending the trademark application to a remote computer.

Examiner agrees that Chauchard teaches the use of a local computer to facilitate filing a trademark. However, Chauchard was originally filed in 2000. It is a natural progression, with the wide-spread use of the internet and web sites which facilitate many services, that rather than using a program to file for a trademark, a web site may be used. Further, Go Daddy provides a web site which provides the service of registering domain names; it would be obvious to combine Go Daddy's registration service with other, related services, such as registering those same domain names as a trademark.

Applicant's second argument - that Chauchard has defined its "remote computer" in such a way that it clearly does not teach or include an official government trademark office - is moot. Chauchard states that the trademark application is transmitted to the proper government office once it has been prepared (paragraph 3). Therefore, Chauchard does teach assisting the Entrepreneur in filing a trademark with the United States Patent and Trademark Office.

Claim Rejections - 35 USC § 112

1. **Claims 1-19 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

Art Unit: 3689

out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 13, and 19 state "the Facilitator's web site accepting an Entrepreneur over the Internet," which is vague and indefinite. It is unclear how an Entrepreneur is accepted by the web site.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1-3, 7-9, 13-15, and 19 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy, www.godaddy.com, 02 February 2003 (hereinafter referred to as "Go Daddy", in view of Chauchard et al. (US 20020042719 A1), based on the same reasoning provided in Examiner's previous Office Action.

Referring to claim 1:

Go Daddy teaches:

A) the Facilitator's web site accepting an Entrepreneur over the Internet (Section I); and

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy does not teach; however, Chauchard teaches

C) the Facilitator's web site assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Referring to claim 7:

Go Daddy teaches

A) the Facilitator's web site accepting an Entrepreneur over the Internet (Section I); and

B) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting").

Go Daddy does not teach; however, Chauchard teaches

C) the Facilitator's web site assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is

Art Unit: 3689

accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering www.godaddy.com and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Referring to claim 13:

Go Daddy teaches:

A) the Facilitator's web site accepting an Entrepreneur over the Internet (Section I); and

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting").

Go Daddy does not teach; however, Chauchard teaches

D) the Facilitator's web site assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Referring to claims 2, 8, and 14:

Claims 2, 8, and 14 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches assisting the Facilitator's web site assisting the Entrepreneur in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business (Section II).

Referring to claim 3, 9, and 15:

Claims 3, 9, and 15 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches the Facilitator's web site submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines (Section III, as explicated by Section IV).

Referring to claim 19:

Go Daddy teaches:

A) the Facilitator's web site accepting an Entrepreneur over the Internet (Section I); and

B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site (Section I).

C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site (Section I);

D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy does not teach; however, Chauchard teaches

D) the Facilitator's web site assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

3. **Claims 4-6, 10-12, and 16-18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard, as applied to claims 1-3, 7-9, 13-15, and 19, above, and further in view of the United States Patent and Trademark Office, www.uspto.gov, 29 February 2000 (hereinafter referred to as "USPTO") based on the same reasoning provided in Examiner's previous Office Action.

Referring to claims 4, 10, and 16:

Go Daddy and Chauchard fail to teach; however, USPTO teaches linking the Entrepreneur with the official web site for the United States Patent and Trademark Office (Section I).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names as well as

Art Unit: 3689

applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Referring to claims 5, 11, and 17:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office (Section III).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Referring to claims 6, 12, and 18:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the

electronic trademark forms to the United States Patent and Trademark Office (Section II).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/1/09